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EXAMINER

DESIR, PIERRE LOUIS

ART UNIT PAPER NUMBER

2681

DATE MAILED: 02/08/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/731,126

Applicant(s)

JEI, DAE-GUNN

Examiner

Pierre-Louis Desir

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 23 November 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-4,7-9,11,13,14,17-19,21 and 22 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-4,7-9,11,13,14,17-19,21 and 22 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 10 December 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Response to Arguments

1. Applicant's arguments filed 11/23/2005 have been fully considered but they are not persuasive.

2. Applicant argues that Okada does not disclose or suggest a memory for storing the demand of the user, as recited in the claims of the present application.

Examiner respectfully disagrees with Applicant. Okada discloses in paragraphs 7-10 of an interruption key to instruct an interruption of a game being in execution, and a first register to which a first predetermined value is set in response to an operation of the interruption key. Thus, when the user presses the interruption key, this command, which was preset in the first register, instructs an interruption of a game being in execution. Therefore, Okada discloses a memory for storing the demand of the user.

Applicant further argues that Okada arrangement does not disclose or suggest the input of a user demand to set up a non-voice communication or non-voice communication function mode.

Examiner respectfully disagrees with Applicant. Okada discloses in paragraphs 85-106 various registers, such as game key register, an interruption register, a game CPU control register. The game CPU control register (paragraph 98) has a game CPU start flag only. The game CPU start flag is set to "1" in response to an operation of the game start key, and set to "0" in response to an operation of the hold key. Thus, when a user presses (i.e., user's input or command) a predetermined operation is set in response to the operation of the key. The various keys represent an input section for receiving a demand, request, input, and command of a user.

Applicant argues that the interrupting means disclosed by Okada simply monitors the occurrence of an interrupt, which is universal to each and every user. This does not constitute the monitoring of a condition to determine whether a condition satisfies the demand or request of a user. Applicant adds that the condition to be monitored in Okada is firmly fixed and cannot be changed based on the demand of the user. In contrast, in the present invention, each user has the freedom to set up his or her own condition to be monitored so as to determine whether that condition is met.

The claim broadly recites a monitoring section for monitoring whether a condition that satisfies the demand of the user is met while the terminal remains in a voice communication mode is broadly interpreted by examiner. And, as stated by examiner, Okada discloses of monitoring of the occurrence of an interrupt. In addition, whether or not the condition to be monitored in Okada is firmly, and cannot be changed based on the demand of a user, Okada still discloses monitoring of a condition.

Applicant is reminded that the argument “in the present invention in the present invention, each user has the freedom to set up his or her own condition to be monitored so as to determine whether that condition is met” is not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

Applicant further discloses that Okada does not disclose or suggest the step of receiving and storing a demand of a user to set-up a non-voice communication function. Furthermore, adds Applicant, Okada does not disclose or suggest the step of monitoring whether a condition that satisfies the demand of the user is met.

As related to Applicant's argument that Okada does not disclose the step of receiving and storing a demand of a user to set-up a non-voice communication function, Examiner respectfully disagrees. As disclosed above, the operation of the game start key (i.e., receiving of a user input), which is compared to a predetermined value set in the specific register (storing of the command), causes a shift from a voice communication mode to a game mode (see paragraphs 76, 78, 85-106).

As related to Applicant's argument that Okada does not disclose or suggest the step of monitoring whether a condition that satisfies the demand of the user is met, Examiner refers Applicant to above discussion of the same related subject matter.

Applicant argues that Okada does not disclose or suggest the performance of at least one task for implementing a non-voice communication function when a condition that satisfies the demand of the user is met.

Examiner respectfully disagrees. Okada discloses that operation of the game start key causes a shift from a voice communication mode to a game mode (see page 3, paragraphs 76, and 78).

As related to Applicant argument related to claim 17, Applicant is referred to above discussion of the same related subject matter.

Finally, Applicant states that Examiner does not cite any portion of Okada, which would provide a person of ordinary skill in the art, upon reviewing that reference, sufficient motivation. In fact, added applicant, the expression of motivation on the part of the Examiner constitutes the mere expression of an opinion on the part of the examiner, without any extrinsic evidence in support thereof.

Applicant is referred to the abstract of Barnes JR, which would provide a person of ordinary skill in the art, upon reviewing that reference, sufficient motivation.

Claim Rejections - 35 USC § 102

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

4. Claims 1-4, 13-14, 17-19, and 21 are rejected under 35 U.S.C. 102(e) as being anticipated by Okada et al. (Okada), Pub. No. US 20030100347.

Regarding claim 1, Okada discloses a multi-purpose hybrid terminal (i.e., an electronic apparatus having game and phone functions) (see abstract), comprising: an input section for receiving a demand of a user to set up a non-voice communication function in the hybrid terminal (i.e., operation of the game start key causes a shift from a voice communication mode to a game mode, and the device can still detect an incoming call) (see page 3, paragraphs 76, and 78); a memory for storing the demand of the user (see page 1, paragraphs 7-10, and 85-106); a monitoring section for monitoring whether a condition that satisfies the demand of the user is met while the terminal remains in the voice communication mode corresponding to said communication function (i.e., when the interruption key to interrupt the game is operated, the first predetermined value is set to the first register, wherein the game is interrupted by the interrupting means, which would enable a monitoring operation associated with the cellular

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phone function) (see page 1, paragraphs 7-8); an execute section for performing at least one task for implementing the non-voice communication when a satisfaction of the condition satisfying the demand of the user is detected by the monitoring (see page 3, paragraphs 76, and 78); and a mode change section for changing the voice communication mode to a different mode corresponding to the non-voice communication function (i.e., game start key) (see page 3, paragraph 76).

Regarding claim 2, Okada discloses a terminal (see claim 1 rejection) further comprising an alarm for informing the user of the completion of said at least one task (i.e., after the communication is completed, the tone of the game screen is restored) (see page 3, paragraph 78).

Regarding claim 3, Okada discloses a terminal (see claim 1 rejection) wherein said input section includes a key disposed to trigger a change from the voice communication mode to the different mode corresponding to the non-voice communication function (i.e., game start key) (see page 3, paragraph 76).

Regarding claim 4, Okada discloses a multi-purpose hybrid terminal (i.e., an electronic apparatus having game and phone functions) (see abstract), comprising: an input section for receiving a demand of the user to set up a non-voice communication (i.e., operation of the game start key causes a shift from a voice communication mode to a game mode, and the device can still detect an incoming call) (see page 3, paragraphs 76, and 78); a memory for storing the demand of the user (see paragraphs 7-9); a monitoring section for monitoring whether a condition satisfying the demand of the user is met during a voice communication mode that accommodates wireless communication via the terminal (i.e., when the interruption key to

interrupt the game is operated, the first predetermined value is set to the first register, wherein the game is interrupted by the interrupting means, which would enable a monitoring operation associated with the cellular phone function) (see page 1, paragraphs 7-8); an execute section for performing at least one task for implementing the non-voice communication when the condition has been met (see page 3, paragraphs 76, and 78); a mode change section for changing the voice communication mode to the non-voice communication function mode (i.e., game start key) (see page 3, paragraph 76); a first processor including an alarm section for informing the user of the completion of said at least one task (i.e., phone CPU) (see page 3, paragraphs 78 and 81); a second processor for processing the non-voice communication function (i.e., game CPU) (see page 4, paragraph 82); and a dual port memory for exchanging data between the first processor and the second processor (i.e., between the phone CPU and the game CPU, a direct correspondence of an interruption request and transmission data are performed in addition to the correspondence of data via the 8 bit-bus 38 (see page 4, paragraph 83).

Regarding claim 13, Okada discloses method comprising the steps of: receiving and storing in a multipurpose hybrid terminal having a voice communication function, a demand of the user to set up a non-voice communication (see paragraphs 7-9, 76 and 78); monitoring whether a condition that satisfies the demand of the user is met during said voice communication function (i.e., when the interruption key to interrupt the game is operated, the first predetermined value is set to the first register, wherein the game is interrupted by the interrupting means, which would enable a monitoring operation associated with the cellular phone function) (see page 1, paragraphs 7-8); performing at least one task for implementing the non-voice communication when the condition that satisfies the demand of the user is met (see page 3, paragraphs 76, and

78); and informing the user of the completion of preparation for implementing the non-voice communication upon completion of said task (i.e., after the communication is completed, the tone of the game screen is restored) (see page 3, paragraph 78).

Regarding claim 14, Okada discloses a method (see claim 13 rejection) further comprising the step of changing the hybrid terminal to a different mode corresponding to the non-voice communication function (i.e., game start key) (see page 3, paragraph 76).

Regarding claim 17, Okada discloses a computer-readable medium bearing computer-executable instructions for performing a process (i.e., an electronic apparatus having game and phone functions) (see abstract), said instructions comprising: storing in a hybrid terminal providing a voice communication mode and a non-voice communication mode (i.e., an electronic apparatus having game and phone functions) (see abstract), a demand from a user for the hybrid terminal to implement a non-voice communication mode function (i.e., operation of the game start key causes a shift from a voice communication mode to a game mode, and the device can still detect an incoming call) (see page 3, paragraphs 76, and 78); while the hybrid terminal is in said voice communication mode, making a determination as to whether a condition specified by the demand of the user has been met (see page 1, paragraphs 7-8); during said voice communication mode and without interruption of a voice communication mode function, performing at least one task for implementing an non-voice communication mode when said determination establishes that said condition has been met (i.e., operation of the game start key causes a shift from a voice communication mode to a game mode, and the device can still detect an incoming call) (see page 3, paragraphs 76, and 78); and transmitting to the user an indication

of a completion of said at least one task (i.e., after the communication is completed, the tone of the game screen is restored) (see page 3, paragraph 78).

Regarding claim 18, Okada discloses a medium (see claim 17 rejection) said instruction further comprising, shifting from said voice communication mode to said non-voice communication mode upon completion of said task (i.e., if the operator operates the game start key in the incoming call stand-by state, an operation mode is shifted from a voice communication mode to a game mode) (see page 3, paragraph 76).

Regarding claim 19, Okada discloses a medium (see claim 17 rejection) said instructions further comprising, during said voice communication mode performing said task by loading, without interrupting said voice communication function, a computer executable algorithm enabling implementation of the non-voice communication mode function (i.e., if the operator operates the game start key in the incoming call stand-by state, an operation mode is shifted from a voice communication mode to a game mode. Thus, pressing the game start key represents performing the task of loading a computer executable algorithm, which enables the shift to the game mode) (see page 3, paragraph 76).

Regarding claim 21, Okada discloses a medium (see claim 17 rejection) said instructions further comprising: after transmitting said indication, making a decision as to whether the user has responded to said indication by entering into the hybrid terminal a selection corresponding to the non-voice communication function (i.e., operation of the game start key) (see page 3, paragraph 76); and shifting from said voice communication mode to said non-voice communication mode upon entry of said selection (i.e., an operation mode is shifted from a voice communication mode to a game mode) (see page 3, paragraph 76).

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claim 7-9, 11, and 22 are rejected under 35 U.S.C. 103(a) as being unpatentable over Okada in view of Barnes, JR, Pub. No. US 20050136949.

Regarding claim 7, Okada discloses a terminal as described above (see claim 4 rejection).

Although Okada discloses a terminal as described, Okada does not specifically disclose a terminal wherein the non-voice communication function processed by said second processor is a function of receiving a TV broadcast.

However, Barnes, JR discloses a device comprising a communications module, which includes hardware and software to allow the CPU to communicate with external devices and system (page 3, paragraph 37) wherein a device receives a digital signal from a remote receiver, which provides the signal in digital form to the device for immediate presentation e.g., as an MPEG-4 formatted television program (see page 4, paragraph 40).

Therefore, it would have been obvious to one of ordinary skill in the art to combine the teachings to arrive at the claimed invention. A motivation for doing so would have been to provide to the device the added ability to contemporaneously maintain a wireless voice and data link.

Regarding claim 8, Okada discloses a terminal as described above (see claim 4 rejection).

Although Okada discloses a terminal as described, Okada does not specifically disclose a terminal wherein the non-voice communication function processed by said second processor is a detection of a location via a global position satellite.

However, Barnes, JR discloses a device, which transmits location data that is determined by the device's GPS receiver (see page 22, paragraph 220).

Therefore, it would have been obvious to one of ordinary skill in the art to combine the teachings to arrive at the claimed invention. A motivation for doing so would have been to contemporaneously maintain a wireless voice and data link.

Regarding claim 9, Okada discloses a terminal as described above (see claim 4 rejection).

Although Okada discloses a terminal as described, Okada does not specifically disclose a terminal wherein the non-voice communication function processed by said second processor is a detection of a RFID indicator.

However, Barnes, JR discloses a device wherein a detection of a RFID indicator is performed (see page 25, paragraph 252).

Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to combine both teachings to arrive at the claimed invention. A motivation for doing so would have been to provide to the device the added ability to determine the location of the user continuously (see page 25, paragraph 25).

Regarding claim 11, Okada discloses a terminal as described above (see claim 22 rejection).

Although Okada discloses a terminal as described, Okada does not specifically disclose a terminal wherein peripheral comprises a multimedia card reader for reading a multimedia card.

However, Barnes, JR discloses a device) wherein peripheral is a multimedia card reader for reading a multimedia card that stores a program (see page 3, paragraph 29).

Therefore, it would have been obvious to one of ordinary skill n the art at the time of the invention to combine both teachings to arrive at the claimed invention. A motivation for doing so would have been to allow replacement if and when necessary, when the memory becomes full (see page3, paragraph 29).

Regarding claim 22, Okada discloses a terminal as described above (see claim 1 rejection).

Although Okada discloses a terminal as described, Okada does not specifically disclose a terminal wherein a peripheral connected to said multi-purpose hybrod terminal is used for implementing the non-voice communication function.

However, Barnes, JR discloses a device comprising a peripheral device used for implementing function (i.e., a removably detachable memory) (see page 3, paragraph 29).

Therefore, it would have been obvious to one of ordinary skill n the art at the time of the invention to combine both teachings to arrive at the claimed invention. A motivation for doing so would have been to allow replacement if and when necessary, when the memory becomes full (see page3, paragraph 29).

Conclusion


7. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Pierre-Louis Desir whose telephone number is (571) 272-779. The examiner can normally be reached on Monday-Friday 8:00AM- 5:30PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Joseph Feild can be reached on (571) 272-4090. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


Pierre-Louis Desir
02/05/2006


JOSEPH FEILD
SUPERVISORY PATENT EXAMINER